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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,793	02/26/2002	Michael T. Woos	M 6858 HADH/MC	8672

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/085,793

Applicant(s)

WOOS, MICHAEL T.

Examiner

Jila M Mohandesi

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The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/01/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. Replacement drawings were received on June 01, 2004.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the object portion being die-cut to provide an outline of the object", "a pair of jaws", "graphic images that depict the object" and "the object portion being embellished with at least a portion of a graphic image of the object" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations "the object portion is partially separable from the backing card to receive the product there between", "a strip connected to the first end" and "a handle and strip is configured to depict the handle of the object" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

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invention. The description does not describe how the object portion is partially separable from the backing card to receive a product there between and for a strip to be connected at a first end with the backing card.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1- 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the phrase "visually simulates the object" is vague and indefinite. It is not clear as was structure is encompassed by such language.

8. In claim 1, the phrase "the object portion cooperates with the product to secure the product to the backing card" is vague, inaccurate and indefinite. It is not clear what structure is encompassed by such language. It is not clear what structure is the object portion and how the object portion is related to the product and the product to the backing card.

In claim 12, it is not clear how the object portion depicts the object.

Claim 12 recites the limitation "the strip" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsi-Chang (5,915,564). Hsi-Chang '564 discloses a packaging or display device for packaging or displaying a product that in use secures an object, comprising a backing card (10) comprising an object portion (parallel vertical slots 38) that visually simulates the object, wherein the object portion and the backing card comprise a single piece of material, and wherein the object portion cooperates with the product (top section 12) to secure the product to the backing card and to visually simulate the product securing the object when the product is used.

With respect to claim 3, note resilient jaws (14 and 28), which will resiliently hold the object. See Figure 2 embodiment.

11. Claims 1-2, 4, 5 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hart (5,477,964). Hart '964 discloses a packaging or display device for packaging or displaying a product that in use secures an object, comprising a backing card (12) comprising an object portion (tab 18) that visually simulates the object, wherein the object portion and the backing card comprise a single piece of material, and wherein the object portion cooperates with the product (end portion 22) to secure the product to the

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backing card and to visually simulate the product securing the object when the product is used.

With respect to claim 10, note object portion (18) which is partially separable from the backing card to receive a portion of the product there between.

12. Claims 1-2, 4, 5 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Berry (2,973,091). Berry '091 discloses a packaging or display device for packaging or displaying a product that in use secures an object (toy revolver), comprising a backing card (base panel 15) comprising an object portion (openings 16 & 17, flaps 18, 19 & 20 and slot 24) that visually simulates the object, wherein the object portion and the backing card comprise a single piece of material, and wherein the object portion cooperates with the product (panel 22 and tongue 23) to secure the product to the backing card and to visually simulate the product securing the object when the product is used.

With respect to claim 10, note object portion (24) which is partially separable from the backing card to receive a portion of the product they're between.

13. Claims 1- 4 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Roshdy (5,375,717). Roshdy '717 discloses a packaging or display device for packaging or displaying a product that in use secures an object, comprising a backing card (paperboard sheet 100) comprising an object portion (slit/flap 124) that visually simulates the object, wherein the object portion and the backing card comprise a single piece of material, and wherein the object portion cooperates with the product (forward

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extension portion 103) to secure the product to the backing card and to visually simulate the product securing the object when the product is used.

With respect to claim 3, note resilient jaws (127) which will resiliently hold the object. See Figure 5 embodiment.

With respect to claim 10, note object portion (124) which is partially separable from the backing card to receive a portion of the product there between.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over either of Berry '091 or Roshdy '717 in view of Hansen (5,884,456). Each of Berry '091 and/or Roshdy '717 as described above disclose all the limitations of the claims except for the device further comprising graphics. Hansen '456 teaches that it is desirable to provide graphics on a packaging or display device to depicts the object or the use of the product for the benefit of the consumer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide graphics to the packaging or display device of either of Berry '091 or Roshdy '717 as taught by Hansen '456 to provide product information to the consumer.

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16. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over either of Berry '091 or Roshdy '717. With respect to claim 7, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide one or more additional products, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are devices analogous to applicant's invention.

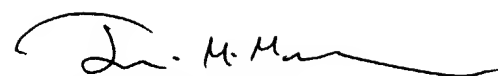
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**JILA M. MOHANDESI  
PRIMARY EXAMINER**



Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
September 13, 2004